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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,145	01/31/2002	Takayuki Suzuki	P 284982 SPO-2477	7654
909	7590	11/04/2003	EXAMINER	
PILLSBURY WINTHROP, LLP			LEE, Y YOUNG	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	

2613

DATE MAILED: 11/04/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/059,145

Applicant(s)  
Takayuki Suzuki et al

Examiner  
Y. Lee

Art Unit  
2613



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 17, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 54-72 is/are pending in the application.
- 4a) Of the above, claim(s) 59, 60, 66, 67, 71, and 72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-58, 61-65, and 68-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 08/805,477.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/03 has been entered.

### ***Election/Restriction***

2. Newly submitted claims 59, 60, 66, 67, 71, and 72 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: originally filed claims 18-37 were directed to the third embodiment whereas newly added claims 59, 60, 66, 67, 71, and 72 are directed to sub-species (i.e. Figs. 3A and 5) of the first embodiment.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 59, 60, 66, 67, 71, and 72 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

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named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119 (a)-(d). The certified copy has been filed in parent Application No. 08/805,477, filed on 2/25/97.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 54, 55, 57, 58, 61, 63-65, and 68-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiyama et al (5,436,655).

Hiyama et al, in Figures 18, 19, 21, 25, 37, 66, and 76, discloses the same TV observation system for an endoscope as specified in claims 54, 55, 57, 58, 61, 63-65, and 68-70 of the present invention, comprising an endoscope 202; a TV camera; a light source 255; an optical element 224 that compounds light emitted from the plurality of LEDs (e.g. 255 and 423); a

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control mechanism 430 that controls electric currents applied to the plurality of LEDs, so that amounts of light emission of the LEDs are set in a desired ratio, wherein the endoscope 202 has an insertion part 207 having a thin and long shape, a holding part 211 continuously extending from a proximal end of the insertion part 207, an eyepiece section 235 formed on the holding part 211, a light guide 217 that introduces illumination to a distal end 227 of the insertion part 207, a light source connecting section (218, 219) formed on the holding part 211 to achieve removable connection of the light source 255, wherein the TV camera has an image pickup element 237 and the TV camera is connected to the eyepiece section 235 of the endoscope 202, wherein the light source comprises a plurality of LEDs (255, 423), the light source is removably connected to the light source connecting section 218, and the light source supplies illumination light to the light guide 217 of the endoscope 202; and wherein the light source is configured to sequentially emit a light of at least three colors (R, G, B), and comprises a LED that emits red light R, a LED that emits green light G, and a LED that emits blue light B.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 56 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiyama et al (5,436,655).

Although Hiyama et al discloses supplying an electric current to the light source 255, it is noted Hiyama et al differs from the present invention in that it fails to particularly disclose a battery as specified in claims 56 and 62. However, Examiner takes Official Notice that such common power supply is notoriously well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to exploit the well known alternative sources of power supply such as the common battery for the TV observation system of Hiyama et al in order to provide a portable endoscope that is more compact in design.

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***Response to Arguments***

9. Applicant's arguments filed 10/17/03 have been fully considered but they are not persuasive.

Applicant asserts on page 6 of the Remarks that Hiyama et al does not have an eyepiece section. However, Figure 25, for example, illustrates an eyepiece section 235 which is formed on the holding part 211 for transmitting video signals from the endoscope 202.

Applicant asserts on page 6 of the Remarks that Hiyama et al does not have a TV camera. However, column 75, lines 1-23 discloses such connection is inherent in a TV observation system.

Applicant asserts on page 7 of the Remarks that Hiyama et al does not disclose, teach or suggest LED. However, Figures 19, 25, 37, 38, 40, and 41, for examples, explicitly illustrate the concept of such plurality of LEDs.

***Conclusion***

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9306, (for formal communications intended for entry)


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(for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

**Or:**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Lee whose telephone number is (703) 308-7584.



**Y. LEE  
PRIMARY EXAMINER**

Y. Lee/yl  
October 31, 2003